

REMARKS

Applicants submitted a response on December 9, 2004 (hereinafter “prior response”). According to the Advisory Action, the amendments set forth in the prior response have not been entered on grounds that doing so would raise “new issues”. These matters are addressed below. The prior response is incorporated herein by reference and it is requested that points raised therein be addressed.

According to the Advisory Action on pg. 2, the prior response raises “new issues”. As a general matter, the claim amendments of the prior response used language from existing claims. There should be no new matter issues raised by such amendments.

Also at pg. 2 of the Advisory Action, the Office identified claim 77 as raising a new issue under 35 USC 112, second paragraph. However, no reason for taking this position is of record. Applicants cannot respond. Clarification of the new matter rejection as it might relate to new claim 77 is requested.

The Office also took that position that new claim 79 was unclear. The issue raised by the Examiner has been addressed by this submission ie., the “Q” was intended at position 11 as set forth by the claim. The “QL” was a typographical error.

Accordingly, Applicants have responded to all issues relating to 35 USC §112, second paragraph, as formulated by the Advisory Action. Consideration of the present submission on the merits is earnestly requested.

Also at pg. 2 of the Advisory Action, the Office took the position that the finality of the previous Office Action (dated September 9, 2004) was appropriate because:

...Applicant is under a duty to disclose [material] information pertaining to patentability. It is noted that both the current application and the ‘319

patent share common inventorship, Applicant is well aware of the '319 patent. The finality of the previous Office Action is deemed proper.

Respectfully, Applicants cannot agree.

The '319 patent (USP 6,555,319) was made of record by the Office in the first (non-final) Office Action (dated March 11, 2004; hereinafter "non-final Office Action"). It is not seen how Applicants' duty to disclose information to the Office, as stated above, relates to patents that are already of record. Clarification is requested. Certainly, Applicants are under no duty to disclose or provide information when that information is of record. See the non-final Office Action (citing the '319 patent). It is not seen how Applicants' knowledge of the '319 patent or inventorship has any bearing on the finality of the last Office Action. Clarification is respectfully requested.

The Office had ample opportunity to use the '319 patent as basis for rejecting claims. Indeed, claims 1-9, 15-18, 21-23, 25-26, 43-44, 55-58, and 62 were rejected over the '319 patent on double-patenting grounds. Claims 10 and 12 were pending at the time of the first Office Action but were not subjected to any double-patenting rejection. See the first Office Action. However, the Office took the position, for the first time in the Final Office Action, that claim 1 (amended with language from claims 10 and 12) was subject to a double-patenting rejection. Clearly, this is a new rejection not made earlier in the First Office Action.

Applicants note that they have relied on the Office's position in the first Office Action that claims 10 and 12 were not subject to any double-patenting rejection. Claim 1 was amended accordingly. Clearly, the instant double-patenting rejection of amended claim 1 is a **new rejection** ie., the Final Office Action is the first time claims 10 and 12 (now embodied in amended claim 1) have been rejected on this basis.

Examiner M. Haddad
Group 1644
USSN 09/990,586
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Respectfully, MPEP 706.07(a) requires that the finality of the prior Final Office Action be withdrawn (emphasis added):

Under present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement**

It is believed the application is in condition for allowance, which action is earnestly solicited. Although it is not believed that any further fee is needed to consider this submission, the Office is authorized to charge such fee to our Deposit Account No. 04-1105 if deemed necessary.

Respectfully submitted,

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